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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

NGUYEN, TRINH T

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/539,019	Applicant(s) GISSLEGARD ET AL.	
	Examiner Trinh T. Nguyen	Art Unit 3644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Election dated 5/1/09.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 17-23 and 28-31 is/are pending in the application.
- 4a) Of the above claim(s) 2-12, 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 17-23 and 29-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/16/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I, claims 1-23, and Species 5, claim 17, in the reply filed on 5/1/09 is acknowledged.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1,17-23,29-31 (it is noted that claim 1 only required "selected from the group consisting of i) thermo-plastic elastomers (TPE), as defined in ISO 18064, ii) plasticized PVC, iii) Vinyl TPE" and the Examiner is selecting "plasticized PVC"; therefore, claims 2-12 and 28 are not being treated because the limitations as claimed in claims 2-12 and 28 are directed to either "thermo-plastic elastomers (TPE)" or "Vinyl TPE") are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1: the phrase "as defined in ISO 18064" is confusing since it does not constitute a limitation in any patentable sense; the phrase "plasticized PVC" is confusing since it is not understood as to what the phrase defines and/or intends to be encompassed; the phrase "vinyl TPE" is confusing since it is not understood as to what the phrase defines and/or intends to be encompassed; and the phrase "said material or combination of materials exhibiting the following properties: a) a hardness between 25 shore A and 50 shore D; b) a Young's modulus between 0.1 MPa and 50 MPa; c) a

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tensile strength above 0.5 MPa; and d) a minimum elongation of 50% without breakage” is confusing since the previously cited limitation “selected from the group consisting of” only requires selecting one of the material from the group and not a combination of materials.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1,17-23,29-31 (as best understood based on the rejection of 35 U.S.C. 112, second paragraph above) are rejected under 35 U.S.C. 103(a) as being unpatentable over Mills (US 4572106).

Mills discloses a milking device comprising at least a teat receiving flexible sleeve, adapted to be positioned on/over a teat, characterized in that wherein at least a first portion thereof comprises a material, selected from the group consisting of i) thermo-plastic elastomers (TPE), as defined in ISO 18064, ii) plasticized PVC, iii) Vinyl TPE (note that lines 30-40 of col. 2, Mills discloses a milking device comprising at least a teat receiving flexible sleeve, adapted to be positioned on/over a teat, characterized in that wherein at least a first portion thereof comprises a material such as polyvinyl chloride or “plasticized PVC” and that the polyvinyl chloride or “plasticized PVC” inherently exhibited the properties of hardness, Young's modulus, tensile strength, and elongation therein).

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Mills lacks to mention a) a hardness between 25 shore A and 50 shore D; b) a Young's modulus between 0.1 MPa and 50 MPa; c) a tensile strength above 0.5 MPa; and d) a minimum elongation of 50% without breakage. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the material of Mills so as to include a material exhibiting the properties of hardness between 25 shore A and 50 shore D, a Young's modulus between 0.1 MPa and 50 MPa, a tensile strength above 0.5 MPa, and a minimum elongation of 50% without breakage, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

For claim 17, as described above, Mills as modified discloses most of the claimed invention except for the use of a specific material that is resistant to chlorine, ozone and to UV irradiation and thermal oxidation. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the material of Mills as modified so as to include a material that is resistant to chlorine, ozone and to UV irradiation and thermal oxidation, since using another type material is considered as a matter of design choice depended on its suitability for the intended use and/or the availability of the material, wherein no stated problem is solved or any new or unexpected result achieved, since it appears that the invention would perform equally well with the type of material used in Mills as modified.

For claim 18, as described above, Mills as modified discloses most of the claimed invention (note that the material in Mills as modified is inherently exhibited the

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property of tear strength therein) except for said material or combination of materials exhibits a tear strength between 5 and 50 kN/m. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the material of Mills as modified so as to include a material or combination of materials exhibits a tear strength between 5 and 50 kN/m, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

For claim 19, as described above, Mills as modified discloses most of the claimed invention (note that the material in Mills as modified is inherently exhibited the property of tensile strength therein) except for the tensile strength of said material or combination of materials is 0.5-40 MPa. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the material of Mills as modified so as to include a material or combination of materials exhibits a tensile strength of 0.5-40 MPa, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

For claim 20, as described above, Mills as modified discloses most of the claimed invention (note that the material in Mills as modified is inherently exhibited the property of elongation therein) except for the elongation of said material or combination of materials is more than 200% before breakage. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the material of Mills as modified so as to include the elongation of said material

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or combination of materials is more than 200% before breakage, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

For claim 21, Mills as modified further discloses is a teat cup liner, adapted to be positioned on/over a teat in a close fit.

For claim 22, Mills as modified further discloses a head portion (2), a sleeve (11) and a milk tube (10a) integrated in a unitary structure.

For claim 23, Mills as modified further discloses a head portion (2), a sleeve (6) and a separate milk tube (10a), connectable with the sleeve.

For claim 29, as described above, Mills as modified discloses most of the claimed invention (note that the material in Mills as modified is inherently exhibited the property of tear strength therein) except for said material or combination of materials exhibits a tear strength between 15-35 kN/m. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the material of Mills as modified so as to include a material or combination of materials exhibits a tear strength between 15-35 kN/m, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

For claim 30, as described above, Mills as modified discloses most of the claimed invention (note that the material in Mills as modified is inherently exhibited the property of tensile strength therein) except for the tensile strength of said material or combination of materials is 5-20 MPa. However, it would have been obvious to one

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having ordinary skill in the art at the time the invention was made to have modified the material of Mills as modified so as to include the tensile strength of a material or combination of materials is 5-20 MPa, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

For claim 31, as described above, Mills as modified discloses most of the claimed invention (note that the material in Mills as modified is inherently exhibited the property of elongation therein) except for the elongation of said material or combination of materials is more than 300% before breakage. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the material of Mills as modified so as to include the elongation of said material or combination of materials is more than 300% before breakage, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1,17-23, and 29-31 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of copending Application No. 11/597,716. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 (narrower) of the application "anticipates" claim 1 (broader) of the copending Application No. 11/597,716. Accordingly, the application claim 1 are not patentably distinct from the copending Application No. 11/597,716 claim 1, since the application claim 1 requires elements (i.e., "comprises a material, selected from the group consisting of i) thermo-plastic elastomers (TPE), as defined in ISO 18064, ii) plasticized PVC, iii) Vinyl TPE, said material or combination of materials exhibiting the following properties: a) a hardness between 25 shore A and 50 shore D; b) a Young's modulus between 0.i MPa and 50 MPa; c) a tensile strength above 0.5 MPa; and d) a minimum elongation of 50% without breakage") while the copending Application No. 11/597,716 claim 1 does not. Thus it is apparent that the more specific application claim 1 encompasses the copending Application No. 11/597,716 claim 1. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been filed an application or granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second application or patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Trinh T. Nguyen whose telephone number is (571) 272-6906. The examiner can normally be reached on M-F (1:30 P.M to 10:00 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Mansen can be reached on (571) 272-6608. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Trinh T Nguyen/

Primary Examiner, Art Unit 3644

8/2/09